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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,952	10/29/2003	Jan R. Westra	1875.4860000	6154
26111	7590	11/01/2005		
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER JONES, STEPHEN E	
			ART UNIT 2817	PAPER NUMBER

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,952	Applicant(s) WESTRA ET AL.	
	Examiner Stephen E. Jones	Art Unit 2817	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 11 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The restriction requirement is deemed moot since all of the remaining claims read on the elected invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admitted prior art Fig. 2 (AAPA) for the reasons of record.

AAPA teaches a programmable interpolating gain attenuator including: a termination resistor (R2); a switch Mna and switch Mnb connect between outputs and the termination resistor; first and second ladder circuits; switches connect the taps to the outputs; the switches can be arbitrarily designated as first, second, and third switches and the first switch can be "on" switches (e.g. M2b and M3b), the second switches can be "off" switches (e.g. M6b-Mnb), and the third switch can be "on" switches (e.g. M4b and M5b) in the same manner as the claims read on the elected Fig. 3B (Claims 6, 7, 8, 9); a plurality of resistors (e.g. multiple R1s and R2) are between the taps of the two ladders (Claim 5); non-consecutive switches (e.g. M2B and M4B) are turned on; and the switches are consecutively arranged (e.g. the 1st switch (M2B and

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M3B) is consecutive with the 3rd switch (M4b and M5b) and is consecutive switch 2 (M6b-Mnb)).

Also, note that the order of the switching on or off of the switches is not patentable in an apparatus claim since only the final product structure is patentable in an apparatus claim (e.g. the last three lines of Claim 6 can be read as a method order of the switching of the switches).

Response to Arguments

3. Applicant's arguments filed 8/12/05 have been fully considered but they are not persuasive.

Regarding Claim 1, Applicant argues that the Claim requires an on-off-on consecutive configuration.

Applicant's argument is not commensurate with what is claimed. The claim merely recites that the three switches are "consecutively arranged", but does not recite that the switches are consecutive in the on-off-on configuration. Any order of the switches in a consecutive configuration meets the present limitation as detailed in the rejections above (e.g. on-on-off (i.e. in order 1st, 3rd, 2nd) is consecutive for the 1st, 2nd, and 3rd switches).

Regarding Claims 1 and 6, Applicant argues that Examiner's statement that only the final product structure is patentable in an apparatus claim seems unsupported.

Applicant's argument is not convincing. In Claim 6, the phrase "followed by" is used in the limitations. A reasonable interpretation of this limitation is for the switches to

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be switched one after another in the claimed order which is a method limitation that is not relevant to the final product structure in that only the resulting switching conditions of the final product are patentable (i.e. the final state of each switch being on or off is patentable, but not the method steps of how the switches became "on or off") (see MPEP 2113, Product-by-Process Claims).

Allowable Subject Matter

4. Claims 10-11 are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

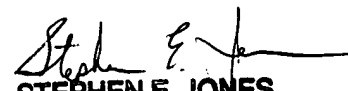
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen E. Jones whose telephone number is 571-272-1762. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on 571-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEJ


STEPHEN E. JONES
PRIMARY EXAMINER